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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,046	09/27/1999	THOMAS MEADE	A-58634-6/RF	9059

7590 01/10/2002
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EXAMINER

JONES, DAMERON LEVEST

ART UNIT PAPER NUMBER

1619

DATE MAILED: 01/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/405,046

Applicant(s)

MEADE ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 16, 17, 22, and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 16, 17, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of Paper No. 13, filed 11/13/01, wherein claims 2-5, 8-11, 13-15, and 18-21 were canceled and claims 12 and 16 were amended.

Note: Claims 12, 16, 17, 22, and 23 are pending.

APPLICANT'S INVENTION

2. Applicant's amended invention is directed to a chelator attached to a peptide.

RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS

3. The Applicant's arguments filed 11/13/01 (Paper No. 11) to the rejection of claims of claims 2, 11, 12, 16-19, 22, and 23 made by the Examiner under 35 USC 103, 112, and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

112 Rejections

The 112 rejections are WITHDRAWN for reasons of record in Applicant's response.

Obviousness-type Double Patenting

The rejection of claims 12, 16, 17, 22, and 23 under the judicially created doctrine of obviousness-type double patenting under US Patent Nos. 5,707,605 and 5,980,862 is MAINTAINED for reasons of record in the Office Action mailed 5/11/01, Paper No. 11.

Note: It is duly noted that Applicant requests that the obviousness-type double patenting rejection be held in abeyance until the claims are indicated as allowable at which time Applicant intends to file a terminal disclaimer.

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103 Rejection

The rejection of claims 12, 16, 17, 22, and 23 under 35 U.S.C. 103(a) as being unpatentable over Garlich et al (US Patent No. 5,133,956) in view of Watson (US Patent No. 5,914,095) is MAINTAINED for the reasons set forth in the Office Action mailed 5/11/01, Paper No. 11, and those found below.

5 Applicant's ^{assertions} ~~asserts~~ may be summed up as the cited prior art does not render the instant invention obvious because the protein component of Watson is not the equivalent of the blocking moiety of the present invention since the objective of the prior art functions to concentrate the bifunctional chelate in a particular.

Applicant's invention is directed to a product, a MRI agent. However, in the response filed 11/13/01, Applicant is asserting that the cited prior art does not render the instant invention obvious because the protein component of Watson is not the equivalent of the blocking moiety of the instant invention. Applicant is reminded that a statement of intended use carries weight in a method claim, not a compound/composition claim.

The references were combined on the basis that both disclose DOTA analogs capable of being conjugated to a site-directed macromolecule such as a peptide and attached to a metal for magnetic resonance imaging.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within


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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


D. L. Jones
Primary Examiner
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January 7, 2002